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MS APPEAL BRIEF - PATENTS
PATENT
3352-0102P

IN THE U.S. PATENT AND TRADEMARK OFFICE

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AUG 9 - 2004

In re application of
Kenneth BROWN et al.

Before the Board of Appeals

Appeal No.:

GROUP 3600

Appl. No.: 09/372,750

Group: 3625

Filed: August 11, 1999

Examiner: J. ZURITA

Conf.: 1821

For: METHOD, SYSTEM, ARTICLE OF MANUFACTURE,
AND PROPAGATED SIGNAL FOR ELECTRONICALLY
ORDERING PHOTOGRAPHIC PRINTS AND GIFTS
FROM PHOTOS

REPLY BRIEF TRANSMITTAL FORM

MS APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 3, 2004

Sir:

Transmitted herewith is a Reply Brief (in triplicate) on behalf of the appellants in connection with the above-identified application.

- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Examiner's Answer was mailed on June 3, 2004.

- ☐ An extension of time under 37 C.F.R. § 1.136(b) to _____ was requested on _____ and was approved on _____.

- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART KOLASCH & BIRCH, LLP

By 

D. Richard Anderson, #40,439

DRA/CMV/jdm
3352-0102P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment(s)

(Rev. 02/12/2004)



MS APPEAL BRIEF - PATENTS
PATENT
3352-0102P

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Kenneth BROWN et al. Conf. No.: 1821
Appl. No.: 09/372,750 Group: 3625
Filed: August 11, 1999 Examiner: J. ZURITA
For: METHOD, SYSTEM, ARTICLE OF MANUFACTURE, AND
PROPAGATED SIGNAL FOR ELECTRONICALLY ORDERING
PHOTOGRAPHIC PRINTS AND GIFTS FROM PHOTOS

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GROUP 3600

REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)

MS APPEAL BRIEF - PATENTS

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 3, 2004

Sir:

Appellants submit herewith a Reply Brief in triplicate as required by 37 C.F.R. 1.192. This Reply Brief responds to the Examiner's Answer dated June 3, 2004.

For clarity, the issues presented in the Appeal Brief filed February 27, 2004, will be repeated, and the reply to the Examiner's Answer will substantially correspond structurally to the argument section in the Appeal Brief.

I. **ISSUES ON APPEAL:**

The issue to be resolved in this application is:

Whether claims 2-3, 5-9, 11-18, 20-35, and 37-60 are unpatentable under 35 U.S.C. § 103(a) based upon the teachings of *Enomoto* in view of *Garfinkle*.

II. NEW POINTS OF ARGUMENT RAISED BY EXAMINER'S ANSWER:

Appellants are providing this Reply Brief to respond to new points of argument raised in the Examiner's Answer. Appellants do not disagree with paragraphs (1)-(10) of the Examiner's Answer. The specific new points of argument that are raised in paragraph (11) to which Appellants disagree are as follows:

1. The Examiner introduces new arguments that he is not affording patentable weight to certain claim elements. With regard to claim 28, the Examiner asserts "...wherein the shell extension is capable of facilitating an order..." should not be afforded patentable weight. Further, with regard to claim 32, the Examiner asserts that the phrase "all ordering information" does not limit the scope of the claim. Appellants response to these assertions are discussed in paragraph C. and I. below.
2. The Examiner introduces support for his rejection of claim 30 by referring to the Official Actions mailed January 23, 2002, and July 8, 2002. Appellants response to this assertion is discussed in paragraph E. below.

III. REPLY:

A. Argument Summary/B. Legal Requirements

The Examiner initially remarks that his comments included in his Answer do not constitute new grounds of rejection. However, it is respectfully submitted that the Examiner has now changed his arguments in support of his position that the claims are unpatentable. For example, with regard to his discussion regarding the claim 28 rejection,

the Examiner introduces an argument that he now believes some of the claim language should not be afforded patentable weight. Appellants respond to these arguments below.

Additionally, the Examiner asserts that Appellants only provide general allegations against patentability. However, it appears the Examiner is only referring to the conclusory statements that appear at the end of Appellants' arguments. It is respectfully submitted that in Appellants' Appeal Brief, Appellants have provided sufficient arguments to support the assertion that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. §103. Appellants respond substantively to these arguments below.

The Examiner generally notes that he has sufficiently provided references that teach or suggest all of the claim elements. However, the Examiner has failed to appreciate the Appellants' arguments for reasons set forth below.

The Examiner, in responding to Appellants' arguments that his interpretation of the term "shell extension" is too broad, asserts it has not been timely traversed. However, Appellants included similar arguments in the Reply filed September 2, 2003. Further, while the Examiner asserts that each pending claim is interpreted as broadly as its terms reasonably allow, it is respectfully submitted that the Examiner is taking an unreasonable interpretation of this claim term that is inconsistent with the ordinary meaning that one of ordinary skill in the art would attribute to it. A shell extension is not equal to a browser as asserted by the Examiner. Appellants respond substantively to these arguments below.

C. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 28.

In responding to Appellants' arguments that the references fail to teach or suggest all of the claim elements, i.e., an extension to the operating system desktop shell interface,

the shell extension supplying third image data to the user station, the Examiner merely notes in his Answer that a browser and a button on the browser teach this element. Appellants respectfully disagree with this assertion. Appellants maintain that while a shell extension may, *arguendo*, be interpreted as an interface, not all interfaces are shell extensions. As previously noted, a shell extension facilitates the access and configuration of a computer's operations. Shell extensions are conventionally utilized for a particular purpose, i.e., to access and configure a computer's operations, as outlined in Appellants' Appeal Brief. However, a browser, as defined by Merriam-Webster's dictionary, is a computer program that is used for accessing sites or information on a network (as the World Wide Web). Browsers are conventionally known for providing an interface wherein a user may access information over a network. These two terms are not interchangeable as suggested by the Examiner.

It is interesting to note that while the Examiner provides numerous definitions in his Answer's Appendix related to general computer terms, he conveniently does not provide definitions that include either "shell extension" or "browser". It appears that the Examiner is attempting to equate terms that may be included in the definitions of "shell extension" and "browser". However, the claim recites "shell extension." As a shell extension is not synonymous with a browser, the Examiner is taking an unreasonably broad interpretation of the claim term. Neither of the references, either alone or in combination, assuming these references are combinable, which Appellants do not admit, teach or suggest "...the shell extension supplying third image data to the user station..." as recited in claim 28. As such, the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. §103.

In responding the Appellants' arguments that the Examiner's rejection fails to establish *prima facie* obviousness by failing to teach or suggest "...wherein the shell extension is capable of facilitating an order...", the Examiner introduces a new argument in his Examiner's Answer that this is claim language that should not be considered in determining patentability. In providing support for this assertion, the Examiner relies on In re Sarkar, 200 U.S.P.Q. 132 (CCPA, 1978). Appellants are confused by this assertion. The Sarkar Court was determining subject matter patentability under 35 U.S.C. §101. In making the quote cited by the Examiner, the Court was merely noting that when considering subject matter patentability, the process for determining whether a claimed invention is merely directed to a mathematical exercise or a method of calculation, the same consideration should be afforded to computer programs. However, the issue at hand is whether claim 28 is rendered obvious under 35 U.S.C. §103. Additionally, Appellants note that claim 28 is directed to a system, not a computer program. As such, unless the Examiner is asserting that claim 28 is now rejected under 35 U.S.C. §101, the reliance on the teachings of this caselaw is clearly misplaced.

As the Examiner has failed to provide any substantive response to the Appellants' arguments that the cited references teach or suggest "wherein the shell extension is capable of facilitating an order..." and further, to Appellants' arguments that there is no motivation to combine the cited references, it appears that the Examiner concedes Appellants' position. As such, for the reasons set forth above, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements and further, by failing to provide

proper motivation to combine the cited references. It is therefore respectfully submitted that claim 28 is not obvious over the teachings of *Enomoto* in view of *Garfinkle*.

D. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 29.

In response to Appellants' argument that the rejection fails to establish *prima facie* obviousness, the Examiner fails to provide any argument other than referring to his statements discussed with regard to claim 29.

It is respectfully submitted that Appellants argued that neither *Enomoto* nor *Garfinkle*, either alone or in combination, teach or suggest the elements contained in claim 29. As discussed above with regard to claim 28, neither of the references, either alone or in combination (assuming these references are combinable, which Appellants do not admit), teach or suggest "an operating system, including an operating system desktop shell interface and an extension to the operating system desktop shell interface, the shell extension supplying third image data to the user station, wherein the shell extension is capable of facilitating an order," as recited in claim 28. The Examiner fails to provide any reasoning in support of his assertion that the references as cited teach or suggest "wherein said network access protocol module delays the outputting any one of the first, second, and third image data to said network sales/order processing server until the order for a plurality of images is complete." As the Examiner has failed to provide a reference that teaches or suggests "wherein said network access protocol module delays the outputting any one of the first, second, and third image data to said network sales/order processing server until the order for a plurality of images is complete," as recited in claim 29, in combination with the elements set forth in claim 28, it is respectfully submitted that

the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103(a). Thus, claim 29 is patentable over *Enomoto* in view of *Garfinkle*.

E. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent 30.

In response to the Appellants' arguments regarding claim 30, the Examiner asserts Appellants have not timely traversed the Examiner's rejection. As noted in Appellants' Brief, the Examiner failed to specifically address this claim element in the Final Rejection filed July 23, 2003, nor in any paper filed subsequent to the Request for Continued Examination on December 6, 2002.

In any event, the Examiner has failed to establish *prima facie* obviousness of claim 30. The Examiner asserts that *Garfinkle* discloses the element of claim 30 by relying on purported teachings of directories and file systems that may exist in various shell extensions and may hold JPEG and other types of digital images. However, it is respectfully submitted that these teachings are not related at all to initiating an order directly from a system file level of the operating system without invoking an additional application program, as recited in the claim. Further, it is well settled that the mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish teaching of a particular claim element. See Continental Can Co., USA, Inc. v. Monsanto, 20 USPQ.2d, 1746, 1749, 1750 (Fed Cir. 1991). As the Examiner has failed to provide any references that teach or suggest all of the elements as recited in claim 30, and further as the Examiner has failed to provide any argumentation at all in the outstanding Official Action, it is respectfully submitted that claim 30 is not obvious over the references as cited.

F. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 31.

In response to Appellants' argument that the rejection fails to establish *prima facie* obviousness of claim 31, the Examiner again fails to provide any response to Appellants' argument other than referring to those statements made in the outstanding Official Action.

It is respectfully submitted that claim 31 is directly dependent on claim 28. Claim 28 sets forth a system that includes a shell extension supplying third image data to the user station, wherein the shell extension is capable of facilitating an order. Claim 31 recites that the network access protocol module is a plug-in module. As noted above, claim 28 is not rendered obvious over the references as cited. As such, claim 31 is not obvious as the cited references fail to teach or suggest the combination of elements as set forth in claim 31. As the Examiner has failed to provide references that teach, either alone or in combination, all of the claim elements of claim 31, it is respectfully submitted that claim 31 is not obvious over the references as cited.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

G. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 46.

In response to Appellants' argument that the rejection fails to establish *prima facie* obviousness of claim 46, the Examiner again fails to provide any response to Appellants' argument other than referring to those statements made in the outstanding Official Action.

It is respectfully submitted that claim 46 is directly dependent on claim 28. Claim 28 sets forth a system that includes a shell extension supplying third image data to the user

station, wherein the shell extension is capable of facilitating an order. Claim 46 recites that the user station displays a locally stored thumbnail image corresponding to any one of the first, second, and third image data while sending ordering information to the network sales/order processing server. As noted above, the claim 28 is not obvious over the references as cited. As such, claim 46 is not obvious as the cited references fail to teach or suggest the combination of elements as set forth in claim 46. As the Examiner has failed to provide references that teach, either alone or in combination, all of the claim elements of claim 46, it is respectfully submitted that claim 46 is not obvious over the references as cited.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

H. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 47.

In response to Appellants' argument that the rejection fails to establish *prima facie* obviousness of claim 47, the Examiner again fails to provide any response to Appellants' argument other than referring to those statements made in the outstanding Official Action.

It is respectfully submitted that claim 47 is directly dependent on claim 46, which depends from claim 28. Claim 46 sets forth a system that includes a shell extension supplying third image data to the user station, wherein the shell extension is capable of facilitating an order. Claim 47 recites wherein said network access protocol module sends said network sales/order processing server a pointer to said thumbnail image locally stored at said user station. As noted above, the claim 28 is not obvious over the references as cited. As such, claim 47 is not obvious as the cited references fail to teach or suggest the

combination of elements as set forth in claim 47. As the Examiner has failed to provide references that teach, either alone or in combination, all of the claim elements of claim 47, it is respectfully submitted that claim 47 is not obvious over the references as cited.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

I. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 32.

In responding to Appellants' arguments regarding claim 32, it appears that the Examiner, again, introduces a new argument and changes his purported *prima facie* arguments that he is not affording patentable weight to all of the claim elements. The Examiner asserts that the term "all" as it relates to ordering information does not limit the scope of the claim and should not be afforded patentable weight. Appellants respectfully disagree with these assertions.

In supporting his arguments that the references in combination teach the claim elements, the Examiner notes that the references teach order buying and selling image-related goods for digital images. The Examiner relies in his Answer on general statements regarding the ability to order and deliver digital prints. These teachings are insufficient to specifically suggest "uploading said digital image to said external network entity or another external network entity subsequent to exchanging all ordering information." The Examiner has failed to provide any specific reasoning as to why the word "all" should not affect claim scope. It is respectfully submitted that the term "all ordering information" should be afforded patentable weight and that the cited references, either alone or in combination, fail to teach or suggest this claim element.

As such, Appellants maintain that the Examiner has failed to establish *prima facie* obviousness in his rejection and as such, claim 32 is not obvious over the references as cited by the Examiner.

J. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claims 2-3, 5-9, 33-35, 49, 50-52, and 55-56.

In response to Appellants' argument that the rejection fails to establish *prima facie* obviousness of claims 2-3, 5-9, 33-35, 49, 50-52, and 55-56, the Examiner asserts Appellants have failed to provide any arguments regarding patentability of each of these claims. However, the Examiner fails to appreciate Appellants' arguments, as Appellants argued that the references, either alone or in combination, fail to teach or suggest the elements of claim 32, in combination with the elements as recited in each of the respective dependent claims.

Appellants maintain that the cited references fail to teach or suggest uploading the digital image to the external network entity or another external network entity subsequent to exchanging all ordering information, in combination with the elements as recited in each of the respective dependent claims.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness of claims 2-3, 5-9, 33-35, 49, 50-52, and 55-56 and thus, claims 2-3, 5-9, 33-35, 49, 50-52 are not obvious over the references as cited.

K. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 37.

In responding to Appellants' arguments regarding claim 37, the Examiner merely responds by referring to his arguments regarding claim 32. Appellants maintain that, as

noted above with regard to claim 32, the cited references fail to teach or suggest uploading the digital image to the external network entity subsequent to exchanging all ordering information.

As such, Appellants maintain that the Examiner has failed to establish *prima facie* obviousness in his rejection and thus, claim 37 is not obvious over the references as cited.

L. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claims 11-18, 37-40, 48, and 53-54.

In response to Appellants' argument that the rejection fails to establish *prima facie* obviousness of claims 11-18, 37-40, 48, and 53-54, the Examiner asserts Appellants have failed to provide any arguments regarding patentability of each of these claims. However, the Examiner fails to appreciate Appellants' arguments, as Appellants argued that the references, either alone or in combination fail to teach or suggest the elements of claim 37, in combination with the elements as recited in each of the respective dependent claims.

Appellants maintain that the cited references fail to teach or suggest uploading said digital image to said external network entity or another external network entity subsequent to exchanging all ordering information, in combination with the elements as recited in each of the respective dependent claims.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness of claims 11-18, 37-40, 48, and 53-54, and thus, claims 11-18, 37-40, 48, and 53-54 are not obvious over the references as cited.

M. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 41.

In responding to Appellants' arguments regarding claim 41, the Examiner merely responds by referring to his arguments regarding claim 32. Appellants maintain that, as noted above with regard to claim 32, the cited references fail to teach or suggest uploading said digital image to said external network entity subsequent to exchanging all ordering information.

As such, Appellants maintain that the Examiner has failed to establish *prima facie* obviousness in his rejection and thus, claim 41 is not obvious over the references as cited.

N. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claims 20-27, 42-45, and 57-60.

In response to Appellants' argument that the rejection fails to establish *prima facie* obviousness of claims 20-27, 42-45, and 57-60, the Examiner asserts Appellants have failed to provide any arguments regarding patentability of each of these claims. However, the Examiner fails to appreciate Appellants' arguments, as Appellants argued that the references, either alone or in combination fail to teach or suggest the elements of claim 41, in combination with the elements as recited in each of the respective dependent claims.

Appellants maintain that the cited references fail to teach or suggest uploading said digital image to said external network entity or another external network entity subsequent to exchanging all ordering information, in combination with the elements as recited in each of the respective dependent claims.

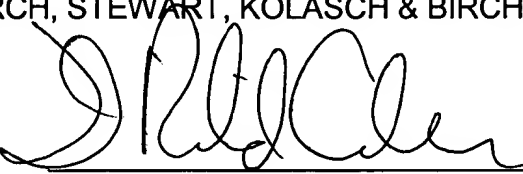
As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

IV. CONCLUSION

For all the reasons set forth above, the rejections in the Examiner's Answer dated June 3, 2004, are improper. It is therefore respectfully requested that the Examiner be reversed on all grounds.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

D. Richard Anderson
Registration No.: 40,439

DRA/CMV

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000